

## REMARKS

Reconsideration of this application is requested.

The Examiner has objected to the drawings for failing to comply with 37 CFR §1.84 (p)(4), because reference characters "24" and "28" have both been used to designate BCS in Fig. 2.

The reason why Applicants have two numbers for the BCS is stated on lines 6-7 and lines 15-17 of page 6 of the specification, which, respectively, read as follows: "Letter mail that is able to be scanned and sorted by MLOCR 23 is sent to bar code sorter/code printer ("BCS") 24. Letter mail that AFCS 22 determines is not optical character readable is sent to bar code sorter/code printer ("BCS") 28.

Claims 1, 3-34 have been provisionally rejected by the Examiner under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35, respectively, of copending Application No. 09/818,792. A terminal disclaimer is attached hereto to overcome the double patenting rejection.

Claims 1-35 have been rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

In Claim 1, lines 2 and 12, the recitation of "would like" was deleted and replaced with the term "wants".

Claims 24-27 have been amended by deleting the words "would like and substituting the term "wants".

Claims 1-3, 5, 12, 16-17, 20, 24-25, and 27-29 have been rejected by the Examiner under 35 USC §102(e) as being anticipated by Kanevsky et al. (US Patent No. 6,285,777).

Kanevsky et al. discloses the following in his Abstract:

"A communication system that transmits and receives combinations of paper mail and electronic mail. The communication system permits a user of the system to send an internet message via post mail including the mailing address for delivery. The post mail office forwards the internet message via e-mail to the internet post office that is the closest to the address. This post office that is local to the address downloads this message, prints a hard copy on a paper, encloses it in an envelop and sends the hard copy to the address via usual local mail. The communication system also permits a user of the system to send paper mail to the post office. The post office scans the paper mail and forwards the scanned information data either to the address directly via internet or via a post office that is local to the addressee."

Kanevsky discloses the following on lines 55-59 of column 12:

"The envelope of the paper mail contains information and instructions from a sender as to how it should be delivered at a destination point (as an e-mail or as a paper mail) or what parts of it should be delivered as an e-mail note or as a paper mail."

Kanevsky et al. does not disclose or anticipate the step of notifying by the recipient to the data center of the manner in which the recipient wants some or all of their mail delivered when the mail has been placed in trays or tubs by the sender in claim 1, as amended, and those claims dependent thereon. In Kanevsky, the recipient does not have the ability to select the manner in which they want some or all of their mail delivered.

Claims 1-4, 6-7, 10-12, 16-17, 20, 24, and 27-32 have been rejected by the Examiner under 35 USC §102(e) as being anticipated by Smith et al. (US 2002/0095306 A1 or US 2002/0042808 A1).

Smith discloses the following in paragraph 0011 of 0042808:

**"[0011]** As will be seen from the detailed description of a specific embodiment herein, the system enables the association with an entity such an individual, a business, an organization, etc. an identifier by which the entity may be addressed and from which the physical location to which an object is to be delivered is readily ascertained. The entity can, from time to time, change the physical location for delivery, while retaining the same identity. Thus, its "address" can be maintained current, even when it frequently changes. Further, the entity can establish different delivery addresses for different types of objects, and can readily change these addresses as circumstances require. The invention is best explained by means of various screens by which the entity receives information concerning the types and status of objects being directed to it, and by means of which it can readily modify the delivery process."

Smith discloses the following in paragraph 009 of 0095306:

**"[009]** The invention is a personal tracking and tracing system that provides a user with information relating to the delivery status of packages, catalogs or other mail pieces sent to or by the user through various catalog companies, delivery services, and/or the postal service. The system provides a user with information about the mail pieces through a personal web page, and thus, the user does not need to know identifying numbers for the respective mail pieces. Further, the user does not even need to know that a particular package has been sent before he or she learns through the personal tracking and tracing system to expect a delivery. The system updates the delivery status information, i.e., expected delivery dates, current locations and so forth, based on information supplied by the delivery companies and/or the postal service. Thus, to keep track of the changes to the delivery status, the user has only to check his or her web page rather than inquire at the various companies or the postal service and/or sort through e-mail messages from them."

Smith does not disclose or anticipate the step of notifying by the recipient to the data center of the manner in which the recipient wants some or all of their mail delivered when the mail has been placed in trays or tubs by the sender in claim 1 as amended, and those claims dependent thereon. In Smith, the recipient does not have the ability to select the manner in which they want some or all of their mail delivered.

Claims 1-3, 12, 16-17, 20-21, 23-24 and 27-29 have been rejected by the Examiner under 35 USC §102(e) as being anticipated by King et al. (US 2002/0002590 A1).

King et al. discloses the following paragraph 0007:

**"[0007]** Therefore, the present invention provides an e-mail system, an e-mail post office, and a method for forwarding e-mail, by using physical address information of the recipient and mapping that to a constant permanent e-mail address. According to one aspect of the present invention, an e-mail system is provided in which the transmitting host transmits the e-mail addressed to the recipient's physical address (e.g., home or work address)."

King et al. does not disclose or anticipate the step of notifying by the recipient to the data center of the manner in which the recipient wants some or all of their mail delivered when the mail has been placed in trays or tubs by the sender in claim 1, as amended, and those claims dependent thereon. In King, the recipient does not have the ability to select the manner in which they want some or all of their mail delivered.

Claims 1-34 have been rejected by the Examiner under 35 USC §103(a) as being unpatentable over Kara et al. (WO 99/21330) in view of EP1063602.

Kara et al. discloses the following in his summary:

"Likewise, information regarding preferred delivery methods of a particular recipient may be utilized by the delivery agents. For

example, a preference to receive all documents possible by e-mail may be stored in a database by the delivery agent."

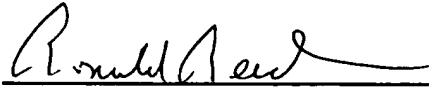
EP1063602 discloses the following in the abstract:

"(57) In accordance with the present invention, when a mailer generates a mail piece, for example using mail generation software in a PC metering system, the mail generation software accesses a database of mailing addresses. This database also contains e-mail address of recipients in the mailing list (address database). If a mailer wants to send advance notice to a recipient that a mailpiece has been sent to the recipient, the mailer can choose this option automatically and use a unique mailpiece ID as an identifier of the upcoming mailpiece. (The mailpiece ID can be generated specially for this purpose and serve as a reference point for the mailer and the recipient). This can be particularly advantageous in a legal environment, when there is a need for timely distribution of information as well as the need for distribution of legally valid hard copy documents. The unique ID number may be printed in plain text in the address block and cryptographically encoded within the DPM. This ID number can be used to provide references and links to other relevant documents as well. When the DPM is scanned upon induction into a postal distribution network, system includes recognition of the recipient's e-mail address and automatically sends notice of intended delivery to the recipient. the notice may also include an estimated date of delivery."

Neither Kara et al. nor EP1063602, taken separately or together, discloses or anticipates the step of notifying by the recipient to the data center of the manner in which the recipient wants some or all of their mail delivered when the mail has been placed in trays or tubs by the sender in claim 1 as amended, and those claims dependent thereon. In Kara and EP1063602, the recipient does not have the ability to select the manner in which they want some or all of their mail delivered.

In view of the above, claims 1-34, as amended, is patentable. If the Examiner has any questions, will he please telephone the undersigned at the telephone number noted below.

Respectfully submitted,



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**Version with Markings to Show Changes Made**

**In the specification:**

***Page 1, first paragraph***

Reference is made to commonly assigned copending patent application ~~Attorney~~  
~~Docket~~ Serial No. ~~F-183~~ 09/818,792 filed herewith entitled "Recipient Elected  
Messaging Services" in the names of Ronald P. Sansone, Robert A. Cordery, and  
Donald G. Mackay; ~~Attorney Docket~~ Serial No. ~~F-236~~ 09/818,721 filed herewith entitled  
"Sender Elected Messaging Services" in the names of Ronald P. Sansone, Robert A.  
Cordery and Donald G. Mackay; ~~Attorney Docket~~ Serial No. ~~E-984~~ 09/817,998 filed  
herewith entitled "Messaging Services for the Visually Impaired" in the name of Ronald  
P. Sansone; ~~Attorney Docket~~ Serial No. ~~E-985~~ 09/818,800 filed herewith entitled  
"Messaging Services For Uniquely Identified Mail" in the name of Ronald P. Sansone;  
~~Attorney Docket~~ Serial No. ~~E-987~~ 09/818,195 filed herewith entitled "Method For  
Determining If Mail Contains Life Harming Materials" in the name of Ronald P. Sansone;  
and ~~Attorney Docket~~ Serial No. ~~E-988~~ 09/818,277 filed herewith entitled "Method For A  
Carrier To Determine The Location Of A Missing Person".

**In the claims:**

1. (Amended) A method that enables a recipient to inform a carrier of the  
manner in which the recipient ~~would like~~ wants some or all of their mail that is placed in  
trays or tubs by the sender and is transported in trays or tubs delivered, said method  
comprises the steps of:

scanning the name and physical address of the recipient and the sender of the mail after the mail has been sealed;

capturing the name and physical address of the recipient and the sender;

translating the name and physical address of the recipient into an e-mail address;

notifying the recipient of the availability of the sealed mail;

depositing with the carrier the sealed mail containing the recipient's name and physical address and the sender's name and address;

notifying by the recipient to the data center of the manner in which the recipient wants some or all of their mail delivered;

notifying by the data center the carrier of the manner in which the recipient ~~would like~~ wants the mail delivered; and

delivering by the carrier mail to the recipient in the manner specified by the recipient to the carrier.

24. (Amended) The method claimed in claim 1, wherein the carrier is notified via e-mail of the manner in which the recipient ~~would like~~ wants the mail delivered.

25. (Amended) The method claimed in claim 1, wherein the carrier is notified via facsimile of the manner in which the recipient ~~would like~~ wants the mail delivered.

26. (Amended) The method claimed in claim 1, wherein the carrier is notified via telephone of the manner in which the recipient ~~would like~~ wants the mail delivered.



27. (Amended) The method claimed in claim 1, wherein the recipient notifies a data center who notifies the carrier of the manner in which the recipient ~~would like~~ wants the mail delivered.